

Oct. 15. 1997

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RATNER & PRESTIA

No. 7727 P. 14/21

BSI-210

PATENT

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21

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: George Goicoechea et al.

: Art Unit: 3304

Serial No.: 08/463,987

: Examiner: M. Milano

Filed: June 5, 1995

: Response Under

FOR: BIFURCATED ENDOLUMINAL

: 37 C.F.R. 1.116

PROSTHESIS

: EXPEDITED PROCEDURE

NE  
AR

TERMINAL DISCLAIMER TO  
OVERCOME DOUBLE PATENTING REJECTION

Assistant Commissioner for Patents

Washington, D.C. 20231

S I R :

I, Allan M. Wheatcraft, represent that I am an attorney of record for this application and that I am authorized to execute this Terminal Disclaimer on behalf of the Assignee of this invention, which Assignee is

Boston Scientific Technology, Inc.

One SciMed Place

Maple Grove, Minnesota 55311-1566.

The extent of the interest in this invention that the Assignee owns is in the whole of this invention, by virtue of an assignment from the previous owner, Mintec, Inc., and by virtue of an assignment from an inventor, Dr. Michael D. Dake, added to this application after the assignment from Mintec. The assignment to Boston Scientific Technology, Inc. from Mintec was recorded on June 17, 1996, Reel 8000, Frame 0405. A copy thereof is attached. The assignment to Boston Scientific Technology, Inc. from Dr. Dake was recorded on March 26, 1997.

The terminal part of the statutory term of any patent granted on the above-identified application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154, 155, 156 and 173 of U.S. Patent No. 5,562,726, is hereby disclaimed, except as provided below. It is agreed that any patent so granted on the above-identified application shall be enforceable only for and during such period that said patent shall be commonly owned with Patent No. 5,562,726, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, disclaimant does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term (as defined in 35 U.S.C. §§ 154, 155, 156 and 173) of Patent No. 5,562,726, in the event that Patent No. 5,562,726 later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is terminated prior to expiration of its full statutory term, except for the separation of legal title stated above.

The undersigned has reviewed all the documents in the chain of title of the patent application identified above and, to the best of the undersigned's knowledge and belief, title is in the Assignee identified above.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

**ASSIGNMENT**

**WHEREAS**, I, Michael D. Dake, of 665 Gerona Road, Stanford, California 94305 (hereinafter referred to as "**ASSIGNOR**"), together with others, have jointly conceived, developed, and made certain inventions, and have assigned all of my right, title, and interest to said inventions, in a Release and Assignment dated May 6, 1996, to MinTec, Inc., a company organized under the laws of Turks and Caicos and having a place of business on Peel Street in Grand Bahama, Bahamas;

**WHEREAS**, **ASSIGNOR** is informed that all right, title, and interest of MinTec, Inc. in said inventions, including specifically U.S. Patent Application Serial Nos. 08/312,881; 08/662,484; 08/461,402; 08/461,513; and 08/463,987, all of which **ASSIGNOR** executed on January 8, 1997, was subsequently reassigned by MinTec, Inc. to Boston Scientific Technology, Inc., a corporation organized and existing under and by virtue of the laws of the State of Minnesota, and having a place of business at One SCIMED Place, Maple Grove, Minnesota 55311-1566 (hereinafter referred to as "**ASSIGNEE**");

**WHEREAS**, **ASSIGNEE** is desirous of acquiring a Confirmatory Assignment of said right, title, and interest in said U.S. patent applications, and the inventions disclosed and claimed therein, from **ASSIGNOR**;

**NOW, THEREFORE**, in consideration of One Dollar (\$1.00) and of other good and valuable consideration, the receipt of which is hereby acknowledged, the undersigned, intending to be legally bound, does hereby sell, assign, and transfer to **ASSIGNEE** **ASSIGNOR'S** entire right, title and interest, for the United States of America, its territories and possessions, and for all foreign countries, in said U.S. patent applications, including the inventions disclosed and claimed therein, all divisions and continuations thereof, all rights to claim priority based thereon, all rights to file foreign applications and to obtain foreign rights corresponding thereto, and all rights to obtain all letters

countries and all rights acquired by MinTec in prior assignments to MinTec of the property assigned hereunder.


2. Upon request of Assignee or its successors or assigns or a legal representative thereof, MinTec shall supply all information and evidence of which it or any of its employees or agents has knowledge or possession, relating to the making and practice of said inventions, to have its officers or employees: testify in any legal proceeding relating thereto; execute all instruments proper to patent the inventions in the United States of America and foreign countries in the name of Assignee; and execute all instruments proper to carry out the intent of this instrument.

3. MinTec hereby assigns to Assignee all of MinTec's rights relating to the obligations imposed on the inventors of said inventions by the above-referenced Assignment.

4. MinTec hereby authorizes and requests the Commissioner of Patents and Trademarks to issue any and all United States Letters Patent, which issue from said application, to Assignee or its successors and assigns, as the owner of all right, title and interest therein.

IN WITNESS WHEREOF, MinTec has placed its signature hereon this 29<sup>th</sup> day of April, 1996.

MinTec Inc.

By:   
Name: Dr. George Goicoechea  
Title: President

PATENT ASSIGNMENT

WHEREAS, MinTec Inc., a corporation organized and existing under and by virtue of the laws of Turks and Caicos Islands, and having a place of business at Freeport, Grand Bahama, Bahamas (hereinafter "MinTec"), is the owner of the entire right, title and interest in and to U.S. Patent Application Serial No. 08/463,987, filed June 5, 1995, entitled BIFURCATED ENDOLUMINAL PROSTHESIS, and the inventions disclosed therein, by virtue of an Assignment which was recorded with the U.S. Patent and Trademark Office at Reel 7260, Frame 0520;

WHEREAS, Boston Scientific Technology, Inc., a corporation organized and existing under and by virtue of the laws of the State of Minnesota, and having a place of business at One SCIMED Place, Maple Grove, Minnesota 55311-1566 (hereinafter "Assignee"), desires to acquire from MinTec the entire right, title and interest in and to said inventions, said application, and all patents which may in the future be issued for said inventions and from said application;

NOW, THEREFORE, in consideration of the mutual covenants of the parties set forth below and in related contractual undertakings of the parties hereto, including one dollar (\$1.00) and other good and valuable consideration, the receipt of which is hereby acknowledged, and intending to be legally bound, MinTec agrees as follows:

1. MinTec hereby grants, to Assignee, MinTec's entire right, title and interest, for the United States of America, its territories and possessions, and for all foreign countries, in said inventions, said patent application, and all patents which may in the future be issued for said inventions and said application, and in and to all divisions and continuations thereof, all rights to claim priority based thereon, all rights to file foreign applications on said inventions, and all letters patent and reissues thereof, issued or issuing for said inventions in the United States of America and in any and all foreign

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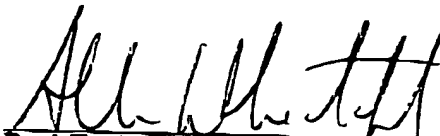
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The Assistant Commissioner for Patents is hereby authorized to charge the Patent Application processing fee of \$55 under 37 C.F.R. § 1.20(d) to Deposit Account 18-0350

Respectfully Submitted,



Paul F. Prestia, Reg. No. 28,031

Allan M. Wheatcraft, Reg. No. 36,307

Attorneys for Applicants

AMW/mjs

Enclosure: Two Assignments

Dated: October 15, 1997

Suite 301

One Westlakes, Berwyn

P.O. Box 980

Valley Forge, PA 19482

(610) 407-0700

The Assistant Commissioner for Patents is hereby authorized to charge payment to Deposit Account No. 18-0350 of any fees associated with this communication.

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office (Fax No. (703) 308-0758) on the date shown below.

October 15, 1997

